

ATTORNEY DOCKET NO. 01173.0003U2  
Application No. 09/929,266

Applicants note that, pursuant to 37 C.F.R. § 1.141 and MPEP § 809.02(b), should a generic claim be found allowable, Applicants are entitled to allowance of claims covering a reasonable number of species.

In regard to designation of generic claims, applicants refer to MPEP § 806.04(e) which states that "[c]laims may be restricted to a single disclosed embodiment (i.e. a single species, and thus be designated *a specific or species claim*), or a claim may include two or more of the disclosed embodiment...(and thus be designated *a generic or genus claim*)" (emphasis in original). In this regard, Applicants note that claims 11-17, 35-41, 94, 187-511, and 517 require peptide reporter signals. However, Applicants note that the claims can include other, unspecified components, including other types of reporter signals. In other words, claims 11-17, 35-41, 94, 187-511, and 517 do not exclude the use of other types of reporter signals. Similarly, although claim 519 specifies that the reporter signals are peptide nucleic acids, the method of claim 519 can include the use of other, unnamed types of reporter signals, including peptide reporter signals. Accordingly, applicants note that, with respect to the peptide reporter signals, claims 1-521 are generic to peptide reporter signals.

Applicants traverse the restriction requirement as currently set forth for the following reasons. To be valid, a restriction requirement must establish both that (1) the "inventions" are either independent or distinct, and (2) that examination of more than one of the "inventions" would constitute a burden to the Examiner. First, the Office Action mailed February 7, 2003, fails to set forth reasons why the "species" are distinct (which is required for a proper restriction requirement). Second, Applicants note that election of species should not be required if the species claimed would be considered unpatentable over each other (see MPEP § 808.01(a)).

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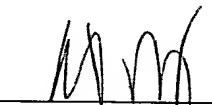
Although Applicants do not state or admit that the species would be unpatentable over each other, Applicants urge that this point should be carefully considered by the Examiner in regard to the identified species. Finally, Applicants note that the restriction requirement does not provide sufficient basis to indicate that examination of more than one of the "species" would overly burden the Examiner.

Favorable consideration of claims 1-521 is earnestly solicited.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$55.00, representing the fee for a small entity under 37 C.F.R. § 1.17(a)(1) is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

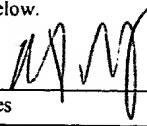
NEEDLE & ROSENBERG, P.C.

  
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Robert A. Hodges  
Registration No. 41,074

NEEDLE & ROSENBERG, P.C.  
Customer Number 23859  
(404) 688-0770  
(404) 688-9880 (fax)

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date indicated below.

  
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Robert A. Hodges

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Date

4/4/2003